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# REMARKS

Claims 7, 14, and 20 stand rejected under 35 U.S.C § 102(b) as being anticipated by Whittaker, *et al.* (EP 1109390). Claims 1-6, 8-13, and 15-19 stand rejected under 35 U.S.C § 103(a) as unpatentable over Morganstein, *et al.* (U.S. Patent No. 5,901,203) and Whittaker, *et al.* (EP 1109390) in view of Wilcox, *et al.* (U.S. Patent No. 6,404,856). As will be shown below, Morganstein, Whittaker, or Wilcox alone or in combination, do not teach a method, system, or computer program product for identifying a particular callee as claimed in the present application. Claims 1-20 are therefore patententable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-20.

## Claim Rejections – 35 U.S.C. §102 Over Whittaker

Claims 7, 14, and 20 stand rejected under 35 U.S.C § 102(b) as being anticipated by Whittaker, *et al.* (EP 1109390). To anticipate claims 7, 14, and 20 under 35 U.S.C. § 102(b), two basic requirements must be met. The first requirement of anticipation is that Whittaker must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Whittaker must enable Applicants' claims 7, 14, and 20. Whittaker does not meet either requirement and therefore does not anticipate Applicants' claims.

## Whittaker Does Not Disclose Each and Every
## Element of Applicants' Claims 7, 14, and 20

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As discussed in detail below, Whittaker does not disclose each and every element of claims 7, 14, and 20.

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Independent claim 7 claims:

> A method for voicemail searching, the method comprising:
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> storing, in association with a voicemail message, message text converted from the voicemail message;
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> receiving, from a particular voicemail user, at least one search keyword; and
>
> selecting, in dependence upon the search keywords and the message text, one or more voicemail messages for the particular voicemail user.

Claims 14 and 20 claim system and computer program product aspects of the method claimed in claim 7. Regarding claims 7, 14, and 20, the Office Action states:

> Whittaker teaches a voicemail method (Fig. 2, #30). His voicemail processor comprising: (a) storing a converted voicemail text with the associated message (transcribed voice messages, col. 3, line 54 with Fig. 3, #84), (b) receiving search keywords (pa. 0034 with Fig. 4), and (c) selecting voicemail messages in dependence on the selected keywords (pa. 0035 with Fig. 5)."

Applicants respectfully propose that Whittaker does not disclose each and every element of claims 7, 14, and 20 of the present application. Whittaker column 3, line 54, actually discloses raw audio "processed by transcribing the raw audio 46 into text ..." Clearly Whittaker's transcribing raw audio into text does not disclose storing message text in association with a voicemail message as claimed in the present application.

Moreover, Whittaker at paragraph 0034 in fact discloses a search section 230 that "allows a user to perform free text queries and/or structured text queries on the transcribed voicemails. Again, the free text queries and structured text queries of Whittaker cannot

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be said to disclose receiving, from a particular voicemail user, at least one search keyword as claimed in the present application.

In addition, Whittaker at paragraph 0035 in fact discloses "a search results display as shown in FIG. 5." Clearly the search results display of Whittaker does not disclose selecting, in dependence upon search keywords and message text, one or more voicemail messages for the particular voicemail user as claimed in the present application.

Because Whittaker does not disclose each and every element of claims 7, 14, and 20, the rejections of these claims under 35 USC 102 should be withdrawn. These claims should be allowed.

### Whittaker Does Not Enable Applicants' Claims 7, 14, and 20

Not only must Whittaker disclose each and every element of claims 7, 14, and 20 of the present invention within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Whittaker must be an enabling disclosure of Applicants' claims 7, 14, and 20 within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in Hoeksema stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema,* 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Whittaker places Applicants' claims 7, 14, and 20 in the possession of a person of ordinary skill in the art, Whittaker is legally insufficient to anticipate Applicants' claims 7, 14, and 20 under 35 USC 102(b).

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Whittaker in fact does not place each and every element of claims 7, 14, and 20 in the possession of a person of skill in the art. Whittaker at column 3, line 54, for example, actually discloses raw audio "processed by transcribing the raw audio 46 into text ..." Clearly Whittaker's transcribing raw audio into text does not place in the possession of a person of skill in the art storing message text in association with a voicemail message as claimed in the present application.

Moreover, Whittaker at paragraph 0034 in fact discloses a search section 230 that "allows a user to perform free text queries and/or structured text queries on the transcribed voicemails. Again, the free text queries and structured text queries of Whittaker cannot be said to place in the possession of a person of skill in the art receiving, from a particular voicemail user, at least one search keyword as claimed in the present application.

In addition, Whittaker at paragraph 0035 in fact discloses "a search results display as shown in FIG. 5." Clearly the search results display of Whittaker does not place in the possession of a person of skill in the art selecting, in dependence upon search keywords and message text, one or more voicemail messages for the particular voicemail user as claimed in the present application.

Because Whittaker does not place each and every element of claims 7, 14, and 20 in the possession of a person of skill in the art, the rejections of these claims under 35 USC 102 should be withdrawn. Claims 7, 14, and 20 are patentable and should be allowed.

### Claim Rejections – 35 U.S.C. §103

Claims 1-5, 8-12, and 15-18 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Morganstein, et al. (U.S. Patent No. 5,901,203) in view of Wilcox, et al. (U.S. Patent No. 6,404,856). Claims 6, 13 and 19 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Whittaker, et al. (EP 1109390) in view of Wilcox, et al. (U.S. Patent No. 6,404,856). As will be shown below, Morganstein, Whittaker, or Wilcox alone or in combination, do not teach or suggest each and every element of claimed in the

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present application.

To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to modify Morganstein and Whittaker or to combine Morganstein and Wilcox or Whittaker and Wilcox. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed modifications of Morganstein and Whittaker or the proposed combinations of Morganstein and Wilcox, or Whittaker and Wilcox. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed modifications of Morganstein and Whittaker or the proposed combinations of Morganstein and Wilcox or Whittaker and Wilcox must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As demonstrated below, the modifications of Morganstein and Whittaker or the combinations of Morganstein and Wilcox or Whittaker and Wilcox cannot establish a prima facie case of obviousness. The rejection of claims 1-5, 8-12, and 15-18 should therefore be withdrawn and the case should be allowed.

### Morganstein And Wilcox

Claims 1-5, 8-12, and 15-18 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Morganstein in view of Wilcox. Claim 1 claims a method for voicemail searching. Claims 8 and 15 claim respectively system and computer program product aspects of the method of claim 1. Claims 2-5, 9-12, and 16-18 depend respectively from independent claims 1, 8, and 15.

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## The Combination Of Morganstein And Wilcox
## Does Not Teach or suggest All Of Applicants' Claim Limitations

The proposed combination of Morganstein and Wilcox cannot establish a prima facie case of obviousness. To establish a prima facie case of obviousness, the proposed combination of Morganstein and Wilcox must disclose or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

Claim 1 claims:

A method for voicemail searching, the method comprising:

storing, in association with a voicemail message, a voiceprint of a caller;

storing at least one caller speech tag in association with the voiceprint;

identifying, in dependence upon the voiceprint, a caller who leaves a voicemail message;

receiving, from a particular voicemail user, at least one search keyword; and

selecting, in dependence upon the search keyword and the caller speech tag, one or more voicemail messages for the particular voicemail user.

The Office Action states:

Morganstein teaches a caller identification system (col. 7, lines 9-12 with Fig. 2) comprising: (a) storing a caller voiceprint (record the caller utterance, col. 11, lines 1-2) in associated with the caller (utterance in caller record, col. 9, lines 20-25 with Fig. 3c) and (b) identifying a caller (col. 11, lines 29-33).

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Morganstein does not teach: (c) storing speech tags, (d) receiving search keywords, and (e) selecting voicemail messages.

However, Wilcox teaches audio data annotating and indexing system (Fig. 1) comprising: (c) storing user speech tags (user attaches audio data with properties, audio data, col. 4, lines 19-25 & col. 5, lines 5-12; as well as keywords, col. 6, lines 7-8), (d) receiving search keywords (col. 6, lines 39-41 with Fig. 4), and (e) selecting voicemail messages (col. 6, lines 54-59 with Fig. 5).

The office Action concludes that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Morganstein by Wilcox to implement the voicemail searching methods and systems claimed in the present application.

Applicants respectfully propose that the combination of Morganstein and Wilcox does not disclose or suggest each and every element of claims 1, 8, and 15 of the present application. For example, the Office Action states that Morganstein at column 11, lines 1-2, teaches storing a caller voiceprint. Morganstein at column 11, lines 1-2, actually discloses "...conversion facility 13 and records the digitized utterance at step 218 using recording facility 15." Clearly this recording of a digitized utterance of Morganstein does not disclose or suggest storing, in association with a voicemail message, a voiceprint of a caller as claimed in the present application.

In addition, the Office Action states that Morganstein at column 9, lines 20-25, discloses "in associated with the caller," which Applicants take as a reference to the claimed storing a voiceprint of a caller "in association with a voicemail message." Morganstein at column 9, lines 20-25, in fact discloses a table (reference 160 of Figure 3) bearing records representing callers having associated utterance data for each known caller. There is no mention at Morganstein, column 9, lines 20-25, of associations with voicemail messages. Clearly these caller records with associated utterance data of

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Morganstein do not disclose or suggest storing, in association with a voicemail message, a voiceprint of a caller as claimed in the present application.

The Office Action further states that Morganstein at column 11, lines 29-33, discloses "identifying a caller," which Applicants take as a reference to "identifying, in dependence upon the voiceprint, a caller who leaves a voicemail message," as claimed in the present application. Morganstein at column 11, lines 29-33, in fact discloses communication of "one or more match parameters ... to allow DBMS 43 ... to locate ... one or more utterance identifiers ... that compare favorably to the digitized utterance corresponding to unidentified caller 14." Clearly this communication of match parameters of Morganstein does not disclose or suggest identifying a caller who leaves a voicemail message as claimed in the present application.

The Office Action further states that Wilcox at column 4, lines 19-25, and column 5, lines 5-12, discloses "storing user speech tags," which Applicants take as a reference to "storing at least one caller speech tag in association with the voiceprint," as claimed in the present application. Wilcox at column 4, lines 19-25, in fact discloses an audio data system that "... allows a user to indicate the type of information contained in audio data by attaching properties to the audio data." Wilcox at column 5, lines 5-12, in fact discloses property buttons in a user interface for assigning properties to audio data. Clearly the attachment of properties to audio data of Wilcox does not disclose or suggest storing at least one caller speech tag in association with the voiceprint as claimed in the present application.

The Office Action further states that Wilcox at column 6, lines 39-41, discloses "receiving search keywords," which Applicants take as a reference to "receiving, from a particular voicemail user, at least one search keyword," as claimed in the present application. Wilcox at column 6, lines 39-41, in fact discloses "The query window 84 also has a keyword entry box 88 that permits a user to search for audio data and notemarks having a specified keyword." Clearly the keyword entry box of Wilcox does

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not disclose or suggest receiving, from a particular voicemail user, at least one search keyword as claimed in the present application.

The Office Action further states that Wilcox at column 6, lines 54-59, discloses "selecting voicemail messages," which Applicants take as a reference to "selecting, in dependence upon the search keyword and the caller speech tag, one or more voicemail messages for the particular voicemail user," as claimed in the present application. Wilcox at column 6, lines 54-59, in fact discloses a search results window that "... lists the attributes of the retrieved data files in columns." Clearly the retrieved data files of Wilcox do not disclose or suggest selecting, in dependence upon the search keyword and the caller speech tag, one or more voicemail messages for the particular voicemail user as claimed in the present application.

In response, Applicants respectfully note that neither Morganstein nor Wilcox nor any combination of the two discloses or suggests all the elements of the independent claims 1, 18, and 15 in the present application. The proposed combination of Morganstein and Wilcox therefore cannot establish a prima facie case of obviousness. The rejection of Claims 1-5, 8-12, and 15-18 (that is, independent claims 1, 8, and 15 as well as the dependent claims depending from them) should therefore be withdrawn, and these claims should be allowed.

### No Suggestion To Modify Morganstein

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify Morganstein. *In re Vaeck,* 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion to modify Morganstein must come from the teaching of the references themselves, Morganstein or Wilcox, and the Examiner must explicitly point to the teaching within one of the references suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko,* 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck,* 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991);

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*In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond,* 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski,* 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action at page 3 states its rationale for motivation to modify Morganstein as:

> "It would have been obvious at the time the invention was made to a
> person having ordinary skill in the art, to modify Morganstein by Wilcox
> to tag voice messages, to provide the user a feature of keyword search by
> text (indexing audio data for retrieval, Wilcox col. 2, lines 38-41)."

In response, Applicants respectfully note that the Office Action includes not one word pointing to anything anywhere in the references Morganstein and Wilcox evidencing any suggestion or motivation to combine the references. It is improper to reject a claim under 35 USC 103, even if all elements of the claim are disclosed in various prior art reference (which in this case they are not), without some reason given in the prior art why one or ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention. It is not enough merely to state, as was done in this Office Action, that 'it would have been obvious at the time to a person having ordinary skill in the art ...' *In re Regel*, 188 USPQ 132 (CCPA 1975). In the absence of any suggestion to combine in the references themselves, the proposed modification of Morganstein by Wilcox cannot establish a prima facie case of obviousness.

<u>No Reasonable Expectation Of Success In The</u>
<u>Proposed Combination Of Morganstein And Wilcox</u>

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed modification of Morganstein to include storing speech tags, receiving search keywords, and selecting voicemail messages or combination of Morganstein and Wilcox. *In re Merck & Co., Inc.,* 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There can be no reasonable expectation of success in the

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modification of Morganstein by Wilcox if the proposed modification changes the principle of operation of either Morganstein or Wilcox. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Morganstein teaches a computer-based system and method for identifying an unidentified caller (paragraph [54]). To modify Morganstein to create storing speech tags, receiving search keywords, and selecting voicemail messages rather than identifying an unidentified caller would fundamentally change the principle of operation of Morganstein. The proposed combination of Morganstein and Wilcox therefore cannot support a prima facie case of obviousness. The rejections should be withdrawn, and the case should be allowed.

### Whittaker And Wilcox

Claims 6, 13 and 19 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Whittaker, *et al.* (EP 1109390) in view of Wilcox, *et al.* (U.S. Patent No. 6,404,856). The proposed combination cannot establish a prima facie case of obviousness.

### The Combination Of Whittaker And Wilcox
### Do Not Teach or suggest All Of Applicants' Claim Limitations

To establish a prima facie case of obviousness, the proposed combination of Whittaker and Wilcox must disclose or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Independent claim 6 claims:

A method for voicemail searching, the method comprising:

storing, in association with a voicemail message, caller identification data that identifies a caller;

identifying, in dependence upon the caller identification data, a caller who leaves a new voicemail message;

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receiving at least one search keyword from a particular voicemail user; and

selecting, in dependence upon the search keyword and the caller identification data, one or more voicemail messages for the particular voicemail user.

The Office Action states:

Whittaker, applied as above to claims 7, 14, and 20, further teaches storing a caller ID (entity extraction; col. 4, lines 10-12 with Fig. 4, #210) with a desired voicemail message. Whittaker does not teach identifying callers with caller ID's. However, Wilcox teaches identifying callers with caller ID's (col. 5, lines 28-35)."

The Office Action states that Whittaker at column 4, lines 10-12, discloses "storing a caller ID," which Applicants take as a reference to "storing, in association with a voicemail message, caller identification data that identifies a caller," as claimed in the present application. Whittaker at column 4, lines 10-12, in fact discloses "In the present invention, entity extraction will be employed to extract standardized information ... " Clearly the entity extraction of Whittaker does not disclose or suggest storing, in association with a voicemail message, caller identification data that identifies a caller as claimed in the present application.

The Office Action states that Wilcox at column 5, lines 28-35, discloses "identifying callers with caller ID's," which Applicants take as a reference to "identifying, in dependence upon the caller identification data, a caller who leaves a new voicemail message," as claimed in the present application. The Office Action then relies on Whittaker for the remaining two elements of claim 6:

receiving at least one search keyword from a particular voicemail user; and

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selecting, in dependence upon the search keyword and the caller identification data, one or more voicemail messages for the particular voicemail user.

As explained above, however, in the discussion of Whittaker as applied to claims 7, 14, and 20, Whittaker does not disclose or suggest or enable these two claim elements. For all these reasons, the proposed combination of Whittaker and Wilcox cannot establish a prima facie case of obviousness. The rejection of claims 6, 13, and 19 should therefore be withdrawn, and the claims should be allowed.

## No Suggestion or Motivation
## To Combine Whittaker And Wilcox

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify Whittaker. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to modify Whittaker must come from the teaching of the references themselves, and the Examiner must explicitly point to the teaching within at least one of the references suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F,.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action at page 6 states its rationale for motivation to modify Whittaker as:

> It would have been obvious at the time the invention was made to a person having ordinary skill in the art, to modify Whittaker by Wilcox to identify callers by caller ID's, to allow the user to use the inherent design feature of a caller ID.

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In response, Applicants respectfully note that the Office Action includes not one word pointing to anything anywhere in the references Whittaker and Wilcox evidencing any suggestion or motivation to combine the references. It is improper to reject a claim under 35 USC 103, even if all elements of the claim are disclosed in various prior art reference (which in this case they are not), without some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention. It is not enough merely to state, as was done in this Office Action, that 'it would have been obvious at the time to a person having ordinary skill in the art ...' *In re Regel*, 188 USPQ 132 (CCPA 1975). In the absence of any suggestion to combine in the references themselves, the proposed modification of Whittaker by Wilcox cannot establish a prima facie case of obviousness.

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## No Reasonable Expectation Of Success In The Proposed Combination Of Whittaker And Wilcox

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To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed modification of Whittaker to include identifying callers with caller ID's and combination of Whittaker and Wilcox. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There can be no reasonable expectation of success in the modification of Whittaker and the combination of Whittaker and Wilcox if the proposed modification changes the principle of operation of either Whittaker or Wilcox. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Whittaker teaches a "System and method for browsing and searching through voicemail using automatic speech recognition." Whittaker, paragraph (54). To modify Whittaker to include identifying callers with caller ID's would fundamentally change the principle of operation of Whittaker. The proposed combination of Whittaker and Wilcox therefore cannot support a prima facie case of obviousness. The rejection should be withdrawn, and the case should be allowed.
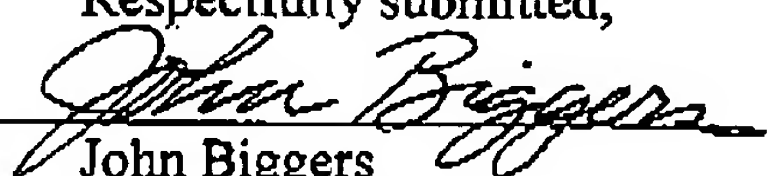
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## Conclusion

Claims 7, 14 and 20 stand rejected under 35 U.S.C § 102(b) as being anticipated by Whittaker. Whittaker does not disclose each and every element of Applicants' claims 7, 14, and 20 and does not enable Applicants' claims 7, 14, and 20. Whittaker therefore does not anticipate Applicants' claims 7, 14, and 20. Claims 1-6, 8-13, and 15-19 stand rejected under 35 U.S.C § 103(a) as unpatentable over Morganstein, *et al.* (U.S. Patent No. 5,901,203) and Whittaker, *et al.* (EP 1109390) in view of Wilcox, *et al.* (U.S. Patent No. 6,404,856). Neither Morganstein nor Whittaker nor Wilcox nor any proposed combination establishes a prima face case of obviousness. Dependent claims 2-5, 9-12, and 16-18 depend respectively from independent claims 1, 8, and 15. These dependent claims include each and every limitation of the independent claims from which they depend. These independent claims stand because their respective independent claim stand. The rejection of all claims 1-20 in the present case should therefore be withdrawn, and the claims should be allowed. Reconsideration of claims 1-20 in light of the present remarks is respectfully requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Date:  February 24, 2005

Respectfully submitted,

By:

John Biggers
Reg. No. 44,537
Biggers & Ohanian, LLP
504 Lavaca Street, Suite 970
Austin, Texas 78701
Tel. (512) 472-9881
Fax (512) 472-9887
ATTORNEY FOR APPLICANTS

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